

Customer No. 31013

Atty. Docket No. 116142/00230

GP-1647
JH

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Pilon et al.
Serial No. : 10/045,534
Filed : October 24, 2001
For : ***METHODS AND COMPOSITIONS FOR THE TREATMENT OF
FIBROTIC CONDITIONS & IMPAIRED LUNG FUNCTION & TO
ENHANCE LYMPHOCYTE PRODUCTION***
Examiner : Rachel B. Kapust
Group Art Unit : 1647

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 1, 2004.

Signature: _____

Henry J. Cittone

RESPONSE TO NOVEMBER 1, 2004 RESTRICTION REQUIREMENT

This Response is submitted in response to the Restriction Requirement issued on November 1, 2004 in connection with the above-identified application. The deadline for response to the November 1, 2004 Restriction requirement is December 1, 2004. Accordingly, this Response is being timely submitted.

In response to the Official Action mailed November 1, 2004, Applicants hereby elect, with traverse, for further prosecution in this application that invention identified in the Official Action as Group I, Claims 1-15 and 34-36. This restriction requirement is respectfully traversed.

In the November 1, 2004 Restriction Requirement, the Examiner stated that restriction to one of the following inventions is required under 35 U.S.C. § 121:

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| Group I | Claims 1-15 and 34-36, drawn to a method of identifying compounds capable of inhibiting fibronectin-mediated processes, classified in class 435, subclass 7.1. |
| Group II | Claims 16-21, drawn to a method of identifying compounds having uteroglobin-like activity, classified in class 514, subclass 2. |
| Group III | Claims 22-27, drawn to a method of identifying a ligand for uteroglobin, classified in class 436, subclass 501. |
| Group IV | Claims 28-33, drawn to a method of identifying compounds capable of modulating uteroglobin-mediated processes, classified in class 424, subclass 9.2. |
| Group V | Claims 37-39, drawn to a method of identifying receptor-ligand pairs, classified in class 436, subclass 501. |

It is respectfully requested that the restriction requirement be favorably reconsidered and withdrawn. Applicants maintain that a search of the prior art when examining claims 1-15 and 34-36 should reveal any prior art for the remaining claims, i.e., 16-21, 22-27, 28-33 and 37-39.

Applicants note that MPEP § 803 states that if the search of an entire application can be made without serious burden, then the Examiner must examine it on the merits, even if it, as Examiner contends, includes claims to independent or distinct inventions. Applicants also respectfully note that the fact that the PTO has chosen to create different classifications does not, in and of itself, result in the need to conduct separate searches.

Applicants submit that even if Groups I-IV represent distinct inventions, a search of the subject matter of each group would not be a serious burden on the Examiner. Applicants note that MPEP § 808.02 states that even if related inventions are shown to be distinct, the Examiner must also show serious burden "by appropriate explanation."

Moreover, as a result of the GATT legislation limiting the term of a patent to twenty years from its effective filing date, the delay in the examination of the non-elected claims will likely result in the patent term for these claims being unnecessarily shortened.

Furthermore, it is likely that the same Examiner would be in charge of the divisional application; but since that divisional application will be examined at a much later date, the Examiner will have to conduct a duplicate, redundant search at the time she examines the divisional application. Alternatively, if a different Examiner is assigned to the divisional application, a significant loss of PTO efficiency would be incurred as a result of the examination of that divisional case.

In view of the foregoing, withdrawal of the requirement for restriction is respectfully requested.

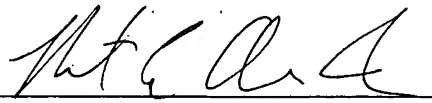
If a telephone interview would be of assistance in the prosecution of this application, Applicants' undersigned attorney invites the Examiner to telephone him at her convenience at the number provided below.

No fee is believed to be necessary in connection with the filing of this Amendment. However, if any fee is required, the Commissioner is hereby authorized to charge such fee(s) to Deposit Account No. 50-0540.

Early and favorable examination on the merits is respectfully requested.

Respectfully submitted,

Dated: December 1, 2004

By: 

Robert E. Alderson, Jr.

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